

Appl. No. : 09/960,236
Filed : September 20, 2001

REMARKS

Reconsideration and allowance of this application, as amended, is respectfully requested. Claims 1-52 were pending in this application prior to entry of the abovementioned amendments. Claims 1-17, 19, 21-32, 34-40, 42 and 44-52 are rejected. Applicants note with appreciation that Claims 18, 20, 33, 41 and 43 are allowed. Claim 34 and 35 are herein canceled. Claims 1-33 and 36-52 are now pending.

Applicants submit that this application is in condition for allowance and such action is earnestly requested. The Examiner's reasons for rejection are addressed below.

Allowable Claims

Applicants note with appreciation that Claims 18, 20, 33, 41 and 43 are allowed.

Section 103 Rejections

The remaining claims are rejected under 35 U.S.C. § 103(a) as being unpatentable over various combinations of references, all of which include U.S. Patent No. 6,413,388 to Uzoh et al. ("Uzoh'388"). Applicants respectfully traverse the § 103 rejections because Uzoh'388 does not qualify as prior art under 35 U.S.C. § 103(c).

Pursuant to M.P.E.P. § 760.02(l)(2), the undersigned hereby states that Uzoh'388 and the present application were, at the time the invention was made, owned by or subject to an obligation of assignment to the same person, which was NuTool, Inc., at the time of the invention. Both cases are currently assigned of record to ASM NuTool, Inc.

Uzoh'388 was filed February 23, 2000, and issued July 2, 2002, whereas the present application was filed September 20, 2001. Thus, Uzoh'388 is available as prior art under 35 U.S.C. § 102(e). However, as stated above, Uzoh'388 and the present application were, at the time the invention was made, owned by or subject to an obligation of assignment to the same person. Pursuant to 35 U.S.C. § 103(c), Uzoh'388 could not serve as prior art for obviousness rejections: "subject matter developed by another person, which qualifies as prior art only under one or more of subsections (e), (f), and (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention

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was made, owned by the same person or subject to an obligation of assignment to the same person.”

Consequently, as the § 103 rejections cannot be maintained without Uzoh’388, Applicants respectfully request that the § 103 rejections be withdrawn.

CONCLUSION

In view of the foregoing amendments and remarks, Applicants respectfully submit that this application is in condition for allowance and request the same. If there is any further hindrance to allowance of the pending claims, the Examiner is invited to contact the undersigned.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

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AMEND

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